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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,608	06/23/2003	Kinya Aota	503.35255VX9	9596

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ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-3873

EXAMINER

STONER, RILEY SHAWN

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/600,608	Applicant(s) AOTA ET AL.	
	Examiner Kiley Stoner	Art Unit 1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/820,231.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6-23-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant is claiming:

Claim 1: "abutting a first panel and a second panel, each of said first and second panels comprising a first plate, a second plate which is substantially in parallel to said first plate, and a third plate connecting a midway of one end side of said first plate and said second plate, and being substantially orthogonal to said first plate; positioning outer faces of said first plates of the first and second panels at substantially a same plane; abutting said third plates together to provide an abutted portion of said first and second panels; and under a condition where said first plates are mounted on a bed and under a condition where a rotary tool is inserted to said abutted portion from an upper location, carrying out a friction stir welding of said abutted portion".

and

Claim 3: "abutting a first panel and a second panel, each of said first and second panels comprising a first plate, a second plate which is substantially in parallel to said first plate, a core member provided between said first plate and said second plate, and an edge member arranged between said first plate and said second plate and formed substantially orthogonal to said first plate; locating faces of outer portions of said first plates of said first and second panels at substantially a same plane; abutting said third plates together to provide an abutted portion of said first and second panels; and under a condition where said first plates are mounted on a bed and under a condition where a rotary tool is inserted to said abutted portion from an upper location, carrying out a friction stir welding of said abutted portion".

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and

Claim 4: "abutting a first panel and a second panel, providing an abutted portion therebetween, each of said first and second panels comprising a first plate, a second plate which is substantially parallel to said first plate, and a third plate connecting a midway of one end side of said first plate and said second plate and being substantially orthogonal to said first plate, said first and second panels being abutted such that outer faces of said first plates of said first and second panels are at substantially a same plane, and said first plates, said second plates and said third plates being abutted at said abutted portion; and carrying out friction stir welding at said abutted portion".

and

Claim 6: first and second panels abutted to each other, forming an abutted portion therebetween, the abutted portion of said first panel and said second panel having a friction stir welding, each of said first and second panels comprising a first plate, a second plate which is substantially parallel to said first plate, a core member provided between said first plate and said second plate, and an edge member arranged between said first plate and said second plate and formed substantially orthogonal to said first plate, outer faces of said first plates of the first and second panels are formed at substantially a same plane, and said first plates, said second plates and said third plates are abutted.

In the instant application, the only mention of the "third member/plate" is in the abstract, which states "The panels 31, 32 each have two substantially parallel plates 33, 34 and a third member 35 connecting the two plates 33, 34". Thus, the subject matter in the claims is not described in the specification. This subject matter is also not found in the parent application 08/820,231 including the originally filed claims. If the applicant attempts to put these limitations in the instant application, the examiner will have to make a new matter rejection unless the applicant is able to convince the examiner that the claimed subject matter has been previously disclosed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "said third plated" in line 10. There is insufficient antecedent basis for this limitation in the claim.

Conclusion

The prior art of record that is cited as of interest is presented on the form-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiley Stoner whose telephone number is (571) 272-1183. The examiner can normally be reached on Monday-Thursday (7:30 a.m. to 6:00 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on Monday-Friday at (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KILEY S. STONER
PRIMARY EXAMINER

Kiley Stoner 3/16/05